

INDEX.

	Page.
1. Statement.....	1
2. Review of the common method of photography..	2
3. Brief of argument.....	3
4. Argument.....	4
5. Patent is invalid because the machine disclosed therein is inoperative.....	4
6. Machine of patent in suit.....	4
7. Inoperativeness of machine of patent in suit....	7
8. Model offered in evidence by appellant is not built according to the disclosure or within the scope of the patent.....	10
9. The construction of the machine shown in the Beidler patent in suit is such that the film necessarily is moved continuously and pro- gressively in one direction only, and precludes such a short reciprocation of the film clamp as is now claimed by appellant.....	15
10. Machine of the patent never commercially used..	18
11. Patent in suit is invalid in view of the prior art:	19
Ratzell, No. 112,380 of 1871.....	19
Parker, No. 117,106 of 1871.....	20
Waterbury, No. 133,394 of 1872.....	20
Niel, No. 157,459 of 1874.....	21
Perry, No. 420,355 of 1890.....	22
Godfrey, No. 475,522 of 1892.....	22
Steffens, No. 429,705 of 1890.....	22
Wight, No. 616,999 of 1899.....	23
British, No. 1,015 of 1899.....	23
Fleischer, No. 683,031 of 1901.....	24
Pollak & Virag, No. 688,115 of 1901.....	24
Dudley, No. 740,828 of 1903.....	25
Beidler, No. 810,388 of 1906.....	25
Beidler (reissue), No. 12,834 of 1908.....	26
Prentiss, No. 830,741 of 1906.....	26

II

	Page.
12. Summary of disclosures in prior art	27
13. The claims in suit do not define a patentable invention in view of the state of the art	28
14. Comparison of Beidler patent in suit with Pollak & Virag and prior Beidler patent 810,388	29
15. Whether or not the claims in suit are valid, there is no infringement as there is no identity of means, operation, or result	32
16. Description of defendant's machine:	
Structure	32
Operation	34
17. Comparison of machine of patent in suit and defendant's machine	36
18. Claims in suit do not cover defendant's machine	38
19. There must be (1) identity of means, (2) identity of operation, (3) identity of result for infringement to exist	43
20. Claims in suit are meaningless, being vague, indefinite, and ambiguous, and are therefore invalid	44
21. Summary	51

ILLUSTRATIONS.

22. Drawing of patent in suit	4
23. Drawing showing that film clamps must be moved continuously in one direction only	16
24. Drawing of defendant's machine	32
25. Drawing showing the manner in which defendant's print-handling device is lifted out of developing pan	41
26. Drawing of machine disclosed in U. S. patent to Pollak & Virag, No. 688,115	29
27. Drawing of machine disclosed in prior Beidler patent No. 810,388	29

III

AUTHORITIES CITED.

	Page.
28. <i>Bliss v. Brooklyn</i> , Fed. Case No. 1546	9
29. <i>Carlton v. Bokee</i> , 17 Wall. 463	45
30. <i>Chandler v. Ladd</i> , Fed. Case No. 2593	9
31. <i>Cimiotti Unhairing Co. v. Amer. Fur Ref. Co.</i> , 198 U. S. 399, 414	43
32. <i>De Laski & Thropp et al. v. U. S. Tire Co.</i> , 235 F. R. 290, 292 (C. C. A.)	15
33. <i>Edison v. Amer. Mutoscope Co.</i> , 114 F. R. 934, 52 C. C. A. 546	46
34. <i>Hall-Borchert v. Ellenan, &c.</i> (C. C. A.), 213 F. R. 341	14
35. <i>Howe Machine Co. v. National Needle Co.</i> , 134 U. S. 388, 394	13
36. <i>Kokomo Fence Mach. Co. v. Kitselman</i> , 189 U. S. 8.	43
37. <i>Leeds & Catlin v. Victor T. Mach. Co.</i> , 213 U. S. 301, 319	44
38. <i>Masseth v. Larkin</i> (C. C. A.), 119 F. R. 171, 174 ..	43
39. <i>McCarty v. L. V. R. R.</i> , 160 U. S. 110, 116	45
40. <i>Mossberg v. Nutter</i> , 135 F. R. 95	14
41. <i>Outlook Envelope Co. v. General Paper Goods Mfg.</i> <i>Co.</i> (C. C. A.), 239 F. R. 877, 879	15
42. <i>Pickering v. McCullough</i> , 104 U. S. 310	30
43. <i>Pittsburgh Meter Co. v. Pittsburgh Supply Co.</i> (C. C. A.), 109 F. R. 644, 651	43
44. <i>Scaife & Sons v. Falls City W. Mills</i> (C. C. A.), 209 F. R. 210	44
45. <i>Smith v. Goodyear Dental Vulcanite Co.</i> , 93 U. S. 486, 493	14
46. <i>State Bank of Chicago v. Hillman's</i> , 180 F. R. 732, 736	46
47. <i>Standard Computing Scale Co. v. Computing Scale</i> <i>Co.</i> (C. C. A.), 126 F. R. 639	43
48. <i>Tate v. B. & O. R. R.</i> , 229 F. R. 141, 144	45

Appellant contends that defendant infringed claims 18, 19, 33, 34, and 40 of the patent in suit. (Rec. p. 16, line 7.) Defendant contends, on the other hand, that the claims in suit are invalid because the structure on which they are predicated is inoperative; that they define no invention over the prior art; and that they are vague, indefinite, and meaningless. Defendant further contends that the Photostat machine used by it did not infringe said claims.

Both sides took testimony, and after consideration thereof the Court of Claims found that defendant did not infringe the claims of appellant's patent in suit and that the patent is invalid and therefore dismissed the petition.

REVIEW OF THE COMMON METHOD OF PHOTOGRAPHY.

As the patent in suit is for an apparatus for producing a photograph it may not be amiss to review, briefly, the common method of producing photographs, which method prevailed long before appellant filed his application.

Prior to the filing of the application on which the patent in suit issued the art of photography was practiced for copying anything desired, including writings. As is well known, a photographic copy is an image of the thing photographed, reproduced on a light-sensitive surface by the action of actinic light rays.

The usual method is to expose a sensitive film to light, in a camera for instance, and to thus produce

an invisible or latent image on said film. To make this image visible, the exposed sensitive film is removed from the camera and (further exposure to the action of actinic light rays being prevented) treated in a chemical solution known as "developer." This treatment or development is accomplished in a light-proof room or cabinet.

The developed image is then made permanent, that is to say proof against the action of actinic light rays, by treating the same with another chemical solution known as "fixing solution." Usually the film, carrying the image, is washed free of the excess developer before being submerged in the "fixing" bath, and after "fixing" it is washed free of the fixing solution and dried.

Appellant's machine purports to be for the exposing, developing, and fixing of a paper film, or, in other words, a machine for carrying out the old method of producing a photograph.

BRIEF OF ARGUMENT.

Defendant will show in the following argument that the patent in suit is invalid because the structure disclosed therein is inoperative; that the model offered in evidence by appellant to show the operativeness of the device of the patent is not built in accordance with the disclosure or within the scope of the patent; that the construction of the machine of the patent in suit is such that the film necessarily is moved continuously and progressively in one direc-

tion only and precludes such a short reciprocation of the film clamp as is now claimed by appellant and illustrated in the model offered in evidence; that the machine of the patent was never commercially used; that the patent is invalid in view of the prior art because the claims in suit do not define an invention patentable over the prior art; that whether or not the claims in suit are valid, defendant's use of the Photostat did not constitute an infringement of the claims, as there was no identity of means, operation, or result between the machine of the patent and defendant's machine; and that the claims are invalid because they are meaningless, being vague, indefinite, and ambiguous.

ARGUMENT.

PATENT IS INVALID BECAUSE THE MACHINE DISCLOSED THEREIN IS INOPERATIVE.

Machine of Patent in Suit.

The patent purports to cover an apparatus, such as illustrated in the patent drawing, for photographing and developing. In this illustration (see inserted enlarged reproduction of patent drawing, page opposite page 4), at the left end of Fig. 1 and beneath the camera F a roll W of sensitized paper is mounted within a light-proof container B. The paper from the roll is supposed to pass through the camera F with the sensitive side uppermost, during which passage successive portions of the paper are subjected to the action of actinic light rays which are reflected onto the sensitized

surface by the reflector H located within the camera F. Disposed between the camera F and the receptacle B for the sensitized roll of paper is a pair of feed rolls D between which the paper is supposed to pass. These feed rolls are for the purpose of feeding the leading edge of the paper between the cutting blades O which are located immediately to the right of the feed rolls, whence the paper passes to clamping devices N. These clamping devices are mounted on the extreme left ends of racks M, which racks are adapted to be moved forward and backward within a light-proof cabinet A. At the extreme right of Fig. 1, mounted on a shaft K, a pair of manually operated pinions L engage the racks M so that the latter may be moved either to the right or to the left, thus moving the clamps N and withdrawing the paper Y from the roll W.

Arranged beneath the racks M within the cabinet A are tanks I, J, and J', which are intended to contain developing, fixing, and washing fluids.

According to the mode of operation set forth in the patent specification, a portion of the sensitized paper Y from the roll W is exposed in the camera F and thereafter the racks M are moved to the right (the leading edge of the paper being engaged by the clamps) until the exposed portion is drawn beyond or to the right of the cutting blades O. The blades are then manually actuated to sever this exposed portion from the remainder of the paper film. The racks are then moved farther to the right to "carry

Fig.1.

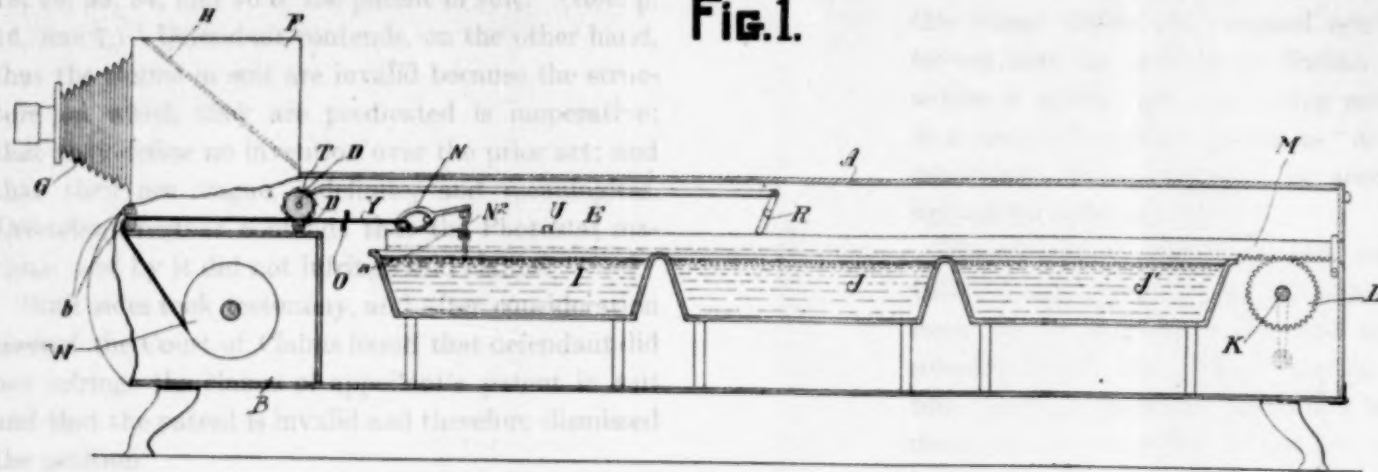
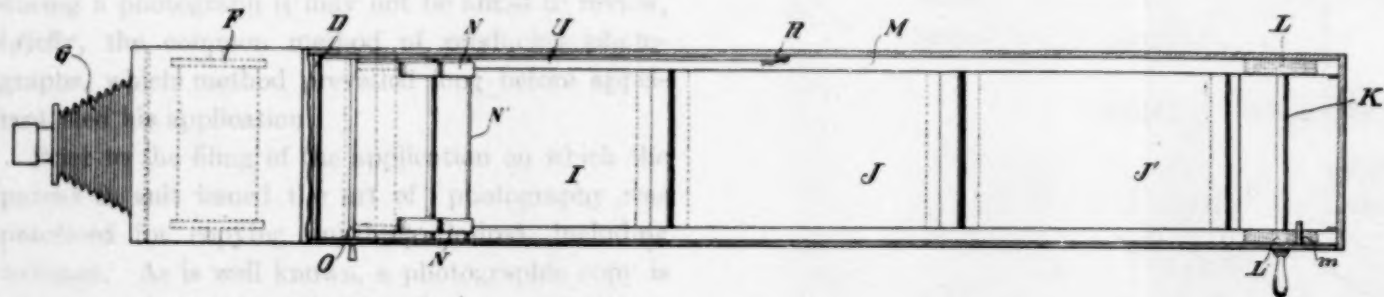


Fig.2.



the film through the tanks." During this movement to the right the racks will extend through openings in the right end of the cabinet A.

Mounted upon the upper face of one of the racks near its left end is the pin U, which when the racks have completed a portion of their movement to the right, carrying with them the severed portion of the film, engages and passes to the right of a lever R pivoted midway between the ends of cabinet A, thereby moving the lever pivotally. Extending from this lever R and pivoted to the upper end thereof is a pawl S which engages a ratchet on the upper roll D of the feed rolls hereinbefore referred to. The actuation of the lever R by the pin U results in the rotation of the feed rolls D so that sufficient paper is fed from the supply roll W to enable the same to be gripped by the clamps M when they return to their initial positions at the left end of the cabinet A adjacent to the feed rolls D and the cutting blades O. Located at the left end of the cabinet A (fig. 1) is some sort of a trip *n* and located at the right end of the cabinet (fig. 2) is a second trip *m*. The trip *n* is supposed to open the jaws of the clamping devices N with the assistance of the device N^2 (which device N^2 is associated with the trip *n* in some manner not described in the specification and not disclosed in the drawing) whereby the paper may be gripped by said clamps. The trip *m* is described as being adapted to open the clamps N at the end of their movement to the right so that the severed por-

tion of the paper will be released and deposited in the last or washing tank J'.

The cabinet A is light-proof and all of the operating mechanism with the exception of the handle on the end of the shaft K at the right end of the cabinet is located within the latter so that it is inaccessible and invisible to the operator.

The rack and clamps carried thereby are inoperative to "carry the film through the tanks" in such manner that it will be subjected to the developing and fixing fluids and the latent image on the film developed. The machine is therefore inoperative to accomplish any useful result. Examination of the patent drawing discloses this fact. It is not surprising that no machines were ever built in accordance with the disclosure of the patent. (Rec. p. 27, Finding VIII.)

• Inoperativeness of machine of patent in suit.

The machine is vitally inoperative.—Assume the exposed portion of the paper to be gripped by the clamps and severed from the remainder of the strip by the blades O. When the racks are now moved to the right, that is to say, away from the camera, the free end of the severed portion of the paper might drop into the first or developing tank with the exposed sensitized side uppermost. A very material portion of the paper, however, would be held above and out of the developing fluid inasmuch as the clamps are disposed at a considerable height above the top of the

tanks. Therefore, at best, only a portion of the paper would be within the liquid. Furthermore, the exposed sensitized surface of the paper would be uppermost and the paper would float on the surface of the developer with the sensitized surface out of contact with it. No means for submerging the paper is provided nor is any contemplated. Hence, if the developer is to act on the film at all it is necessary for the film to gravitate into the same and this gravitation could only take place after the paper had become saturated with the developer. Furthermore the film would not sink evenly and therefore the first parts to sink would be overdeveloped, rendering the ultimate print unsatisfactory. This necessary saturation would consume more time than is permitted for the development of the film. *The film must be subjected to the action of the developer for a comparatively short time and all portions of the film must be submerged simultaneously to obtain a uniform development.* (Rec. p. 28, Finding IX.) The free end of the severed film would simply drop into the first tank and the film would be drawn from this tank successively over the others. The ultimate result would be, *at most*, the uneven development and fixing of an incomplete portion of the exposure. This result, of course, would be entirely unsatisfactory, and so far as any commercial value is concerned the machine is useless. The Court of Claims found as a fact (Rec. p. 28, Finding IX):

The machines of said claims 17, 18, 33, 34, and 40 of the patent in suit are not operative

or useful machines when operated by the mode of operation contemplated and disclosed by the patent, for the reason that, *so operated, they will not submerge all portions of the film in the developing liquid with sufficient rapidity and uniformity to secure proper development of the film.* [Italics ours.]

As stated in the immediately preceding paragraph, appellant's apparatus is not useful in the view of the patent law. The term "useful" when applied to an apparatus means that the machine will accomplish in a practical manner the purpose for which it is intended. It is to be given a practical and not a speculative meaning. It means that the apparatus will operate to accomplish the result as set forth in the specification. Even if the apparatus can be made to accomplish the desired result, it is not useful if it will accomplish the result only to such a restricted extent as to make its use in ordinary industry prohibitive. This has been the interpretation put upon the term "useful" from the earliest decisions up to the present time. (See *Bliss v. Brooklyn*, Fed. case No. 1546; *Chandler v. Ladd*, Fed. case No. 2593; *Troy Laundry Mach. Co., Ltd. v. Columbia Mfg. Co.*, 217 Fed. 787.)

There are other inoperative features of the machine of the patent in suit. Perhaps a mechanic skilled in the art could correct them without the exercise of invention. They show, however, that appellant had no conception of an operative machine when his patent application was filed. In order

that the leading edge of the paper may be gripped by the clamping means N, it is necessary that the paper be fed, by the feed rolls D, between the cutting blades O and the clamping means N when the latter is in the position illustrated in Figure 1 of the patent drawings. If this feeding is to be accomplished, it necessarily must be automatic, as the whole mechanism, with the exception of the operating handle, is inclosed within a light-proof receptacle and therefore inaccessible to the operator. The tendency of the paper when it is drawn from the supply roll W is to follow the curvature of the roll W, if not on the same radius, on a slightly greater one, and this tendency will cause the leading edge of the paper, after it leaves the feed rolls D, to move downwardly and not pass between the cutting blades O. If, by any chance, the paper does pass between the cutting blades, there is still the tendency for it to move downwardly out of the range of the clamping means N. If the paper film is to be engaged by the clamping means N it is necessary that it pass from the camera in a rectilinear path, and this, because of the tendency of the leading edge of the paper to turn downwardly, is a physical impossibility. The paper therefore will never reach the clamps.

**MODEL OFFERED IN EVIDENCE BY APPELLANT
IS NOT BUILT ACCORDING TO THE DISCLOSURE
OR WITHIN THE SCOPE OF THE PATENT.**

Appellant attempted to demonstrate the operative-ness of the device of the patent by a model operated in court. The Court of Claims found as a fact

(Finding VIII, p. 27-28 Rec.) that this model which was offered in evidence by appellant was not constructed in accordance with the patent in suit and operated on a different principle from the patented apparatus. This finding is conclusive. (*U. S. v. New York Indians*, 173 U. S. 464; *The U. S. v. Soci  t   et al.*, 224 U. S. 309-329. Appellant was denied *certiorari* to bring the model and evidence into this court. Sup. Ct. Rep. Vol. 40, p. 9.)

The model (Rec. p. 28) offered in evidence by appellant is not within the scope of the patent because the structure of the model is different from that set forth in the patent, and because the operation of the model is different from that of the patented device.

The Court of Claims found (Rec. p. 28, Finding VIII):

* * * By the method disclosed in the patent, the film with the exposed side uppermost, held at one end by the clamps attached to the rack M and moving in a plane above the pans containing the developing and fixing fluids, is intended, by the outward movement of the rack, to be drawn successively through the developing and fixing fluids, the rack moving in one direction only throughout its entire course, the end of the film next the knife and away from the clamps falling, when severed by the knife, on the surface of the developer in the first pan and possibly partly submerging by gravity. By the method pursued in the operation of the exhibit machine, after the film is severed and the severed end falls on or into the devel-

oper, the rack, by means of the crank, is oscillated back and forth in a range of a few inches until by its repeated reverse action, operating against the resistance of the submerged or free end of the film, the film is finally rolled over, with its exposed side down, in the developer, and submerged. And *in order to permit this changed method of operation without repeated operations of the feeding pawl S, and resultant excessive feeding of film into the developing chamber, the locations of the operating pin U and the developer tray I are materially changed from the disclosures of the patent, the pin being moved to the forward end of the rack M, near the clip N, and the developer tray being moved farther forward and partially under the knife O. Also, an inwardly projecting lip is substituted on the forward end of the developer tray instead of the outwardly projecting lip shown by the patent, this being for the purpose of facilitating the submerging of the film, and of preventing the liquor being splashed over the end of the tray by the movement of the film therein in this new method of its repeated reciprocation or oscillation in the tray and liquid.* [Italics ours.]

It must be remembered that all of the operating mechanism and the tanks are inclosed in a light-proof cabinet so that it would be impossible for the operator to determine the position of the cut-off portion of the paper during the so-called "reciprocation." In other words, the operator could not determine whether or not the paper was resting on

the edge of one of the trays, or what length reciprocation to impart to the clamps; or whether, after reciprocating for a time, the developing, fixing, or washing bath had covered the entire film.

Clearly, the specification gives no such definition to the term "reciprocate" as this. In the patent it is said that—

the said rack M [M insert ours] being alternately reciprocated through the rotation of the shaft K, in opposite directions. (Rec., pp. 5-6.)

Nothing at all is said about any reciprocation of the film, but it is stated distinctly that the so-called reciprocating means is—

to convey the sensitized film through a series of receptacles containing suitable developing and fixing fluids, or through suitable baths according to the requirements. [Italics ours.]

It is evident from the specification of the patent that *when the clamps are moved in a direction away from the camera they are supposed to carry with them the severed portion of the film, and when they move toward the camera the film has been released and they are empty and ready to engage another and later exposed portion of the film.*

It is well settled that a claim is to be construed in the light of the explanation contained in the specification. As the Supreme Court said in *Howe Machine Co. v. National Needle Co.* (134 U. S. 388, 394):

Doubtless a claim is to be construed in connection with the explanation contained

in the specification and it may be so drawn as in effect to make the specification an essential part of it; but since the inventor must particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery, the specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim, and certainly not for the purpose of changing it and making it different from what it is. As remarked by Mr. Justice Bradley, in *White v. Dunbar*, (119 U. S. 47, 52:) "The claim is a statutory requirement prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

Cases of like import are:

Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 493; *Mossberg v. Nutter*, 135 Fed. Rep. 95.

Furthermore, as stated in *Hall-Borchert v. Ellenan, &c.* (C. C. A.), 213 Fed. Rep. 341:

* * * but it is *in the specification* (with such light as the drawings may throw upon it) that we are to find what the alleged invention is. When its language is plain and positive, its disclosure specifically set forth in unmistakable terms, *it is not to be modified by later theories of experts so as to enlarge the claims beyond their legitimate scope.* [Italics ours.]

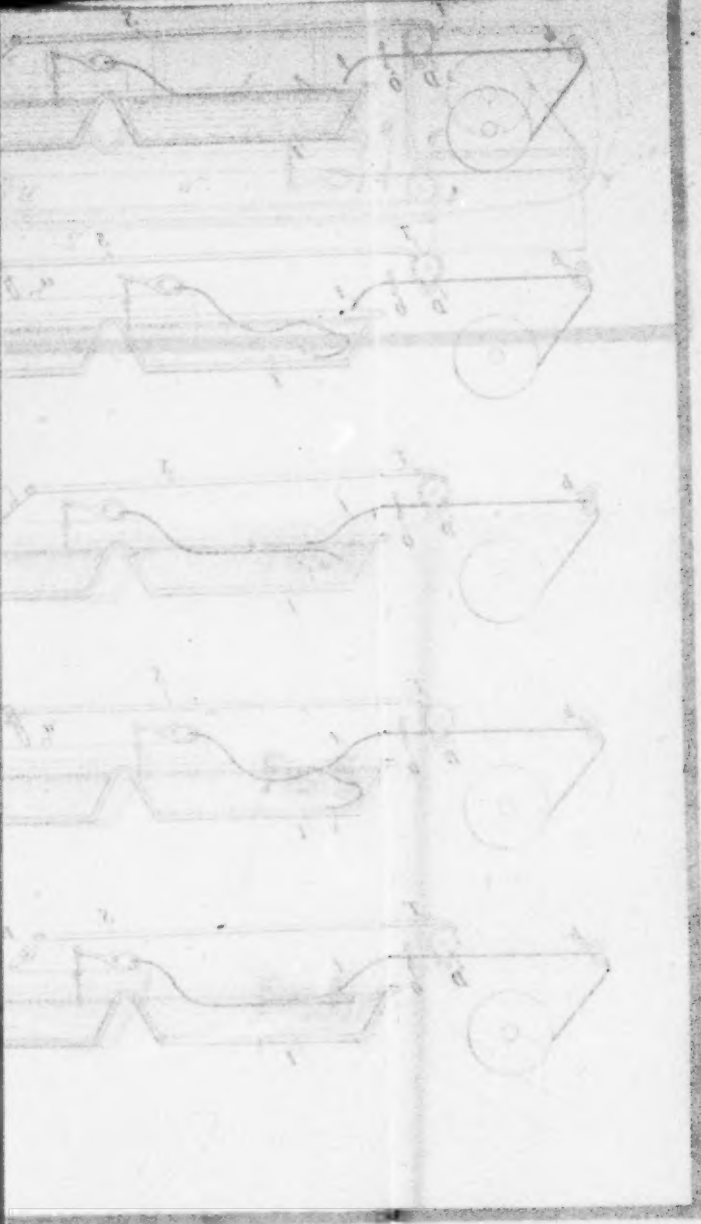


FIGURE 10. (a) (b) (c) (d) (e) (f) (g) (h) (i) (j) (k) (l) (m) (n) (o) (p) (q) (r) (s) (t) (u) (v) (w) (x) (y) (z) (aa) (ab) (ac) (ad) (ae) (af) (ag) (ah) (ai) (aj) (ak) (al) (am) (an) (ao) (ap) (aq) (ar) (as) (at) (au) (av) (aw) (ax) (ay) (az) (ba) (bb) (bc) (bd) (be) (bf) (bg) (bh) (bi) (bj) (bk) (bl) (bm) (bn) (bo) (bp) (bq) (br) (bs) (bt) (bu) (bv) (bw) (bx) (by) (bz) (ca) (cb) (cc) (cd) (ce) (cf) (cg) (ch) (ci) (cj) (ck) (cl) (cm) (cn) (co) (cp) (cq) (cr) (cs) (ct) (cu) (cv) (cw) (cx) (cy) (cz) (da) (db) (dc) (dd) (de) (df) (dg) (dh) (di) (dj) (dk) (dl) (dm) (dn) (do) (dp) (dq) (dr) (ds) (dt) (du) (dv) (dw) (dx) (dy) (dz) (ea) (eb) (ec) (ed) (ee) (ef) (eg) (eh) (ei) (ej) (ek) (el) (em) (en) (eo) (ep) (eq) (er) (es) (et) (eu) (ev) (ew) (ex) (ey) (ez) (fa) (fb) (fc) (fd) (fe) (ff) (fg) (fh) (fi) (fj) (fk) (fl) (fm) (fn) (fo) (fp) (fq) (fr) (fs) (ft) (fu) (fv) (fw) (fx) (fy) (fz) (ga) (gb) (gc) (gd) (ge) (gf) (gg) (gh) (gi) (gj) (gk) (gl) (gm) (gn) (go) (gp) (gq) (gr) (gs) (gt) (gu) (gv) (gw) (gx) (gy) (gz) (ha) (hb) (hc) (hd) (he) (hf) (hg) (hh) (hi) (hj) (hk) (hl) (hm) (hn) (ho) (hp) (hq) (hr) (hs) (ht) (hu) (hv) (hw) (hx) (hy) (hz) (ia) (ib) (ic) (id) (ie) (if) (ig) (ih) (ii) (ij) (ik) (il) (im) (in) (io) (ip) (iq) (ir) (is) (it) (iu) (iv) (iw) (ix) (iy) (iz) (ja) (jb) (jc) (jd) (je) (jf) (jg) (jh) (ji) (jj) (jk) (jl) (jm) (jn) (jo) (jp) (jq) (jr) (js) (jt) (ju) (jv) (jw) (jx) (jy) (jz) (ka) (kb) (kc) (kd) (ke) (kf) (kg) (kh) (ki) (kj) (kk) (kl) (km) (kn) (ko) (kp) (kq) (kr) (ks) (kt) (ku) (kv) (kw) (kx) (ky) (kz) (la) (lb) (lc) (ld) (le) (lf) (lg) (lh) (li) (lj) (lk) (ll) (lm) (ln) (lo) (lp) (lq) (lr) (ls) (lt) (lu) (lv) (lw) (lx) (ly) (lz) (ma) (mb) (mc) (md) (me) (mf) (mg) (mh) (mi) (mj) (mk) (ml) (mm) (mn) (mo) (mp) (mq) (mr) (ms) (mt) (mu) (mv) (mw) (mx) (my) (mz) (na) (nb) (nc) (nd) (ne) (nf) (ng) (nh) (ni) (nj) (nk) (nl) (nm) (nn) (no) (np) (nq) (nr) (ns) (nt) (nu) (nv) (nw) (nx) (ny) (nz) (oa) (ob) (oc) (od) (oe) (of) (og) (oh) (oi) (oj) (ok) (ol) (om) (on) (oo) (op) (oq) (or) (os) (ot) (ou) (ov) (ow) (ox) (oy) (oz) (pa) (pb) (pc) (pd) (pe) (pf) (pg) (ph) (pi) (pj) (pk) (pl) (pm) (pn) (po) (pp) (pq) (pr) (ps) (pt) (pu) (pv) (pw) (px) (py) (pz) (qa) (qb) (qc) (qd) (qe) (qf) (qg) (qh) (qi) (qj) (qk) (ql) (qm) (qn) (qo) (qp) (qq) (qr) (qs) (qt) (qu) (qv) (qw) (qx) (qy) (qz) (ra) (rb) (rc) (rd) (re) (rf) (rg) (rh) (ri) (rj) (rk) (rl) (rm) (rn) (ro) (rp) (rq) (rr) (rs) (rt) (ru) (rv) (rw) (rx) (ry) (rz) (sa) (sb) (sc) (sd) (se) (sf) (sg) (sh) (si) (sj) (sk) (sl) (sm) (sn) (so) (sp) (sq) (sr) (ss) (st) (su) (sv) (sw) (sx) (sy) (sz) (ta) (tb) (tc) (td) (te) (tf) (tg) (th) (ti) (tj) (tk) (tl) (tm) (tn) (to) (tp) (tq) (tr) (ts) (tt) (tu) (tv) (tw) (tx) (ty) (tz) (ua) (ub) (uc) (ud) (ue) (uf) (ug) (uh) (ui) (uj) (uk) (ul) (um) (un) (uo) (up) (uq) (ur) (us) (ut) (uu) (uv) (uw) (ux) (uy) (uz) (va) (vb) (vc) (vd) (ve) (vf) (vg) (vh) (vi) (vj) (vk) (vl) (vm) (vn) (vo) (vp) (vq) (vr) (vs) (vt) (vu) (vv) (vw) (vx) (vy) (vz) (wa) (wb) (wc) (wd) (we) (wf) (wg) (wh) (wi) (wj) (wk) (wl) (wm) (wn) (wo) (wp) (wq) (wr) (ws) (wt) (wu) (wv) (ww) (wx) (wy) (wz) (xa) (xb) (xc) (xd) (xe) (xf) (xg) (xh) (xi) (xj) (xk) (xl) (xm) (xn) (xo) (xp) (xq) (xr) (xs) (xt) (xu) (xv) (xw) (xx) (xy) (xz) (ya) (yb) (yc) (yd) (ye) (yf) (yg) (yh) (yi) (yj) (yk) (yl) (ym) (yn) (yo) (yp) (yq) (yr) (ys) (yt) (yu) (yv) (yw) (yx) (yy) (yz) (za) (zb) (zc) (zd) (ze) (zf) (zg) (zh) (zi) (zj) (zk) (zl) (zm) (zn) (zo) (zp) (zq) (zr) (zs) (zt) (zu) (zv) (zw) (zx) (zy) (zz)

in the specification and it may be so drawn as in effect to make the specification an essential part of it; but since the inventor must particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery, the specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim, and certainly not for the purpose of changing it and making it different from what it is. As remarked by Mr. Justice Bradley, in *White v. Dunbar*, (119 U. S. 47, 52:) "The claim is a statutory requirement prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

Cases of like import are:

Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 493; *Mossberg v. Nutter*, 135 Fed. Rep. 95.

Furthermore, as stated in *Hall-Borchert v. Ellenan, &c.* (C. C. A.), 213 Fed. Rep. 341:

* * * but it is *in the specification* (with such light as the drawings may throw upon it) that we are to find what the alleged invention is. When its language is plain and positive, its disclosure specifically set forth in unmistakable terms, *it is not to be modified by later theories of experts so as to enlarge the claims beyond their legitimate scope.* [Italics ours.]

Also:

De Laski & Thropp C. W. Tire Co. v. United States Tire Co., 235 Fed. Rep. 290, 292 (C. C. A.).

Outlook Envelope Co. v. General Paper Goods Mfg. Co. (C. C. A.), 239 Fed. Rep. 877, 879.

Appellant used considerable ingenuity in the construction of the model, but the facts stand out baldly that the *structure and mode of operation thereof are different from those set forth in the patent.*

It is clear, then, what the term "reciprocating" means in the claims, viz, a movement in one direction to carry the film over a series of tanks in succession, at the end of which movement the film is released, and a movement in the opposite direction over the whole series of tanks to engage the succeeding exposed film portion to repeat the first movement.

THE CONSTRUCTION OF THE MACHINE SHOWN IN THE BEIDLER PATENT IN SUIT IS SUCH THAT THE FILM NECESSARILY IS MOVED CONTINUOUSLY AND PROGRESSIVELY IN ONE DIRECTION ONLY, AND PRECLUDES SUCH A SHORT RECIPROCATATION OF THE FILM CLAMP AS IS NOW CLAIMED BY APPELLANT

An examination of the drawings of the patent in suit will show conclusively that the reciprocating film-feeding means move continuously in one direction and cannot be given the short movements necessary to submerge the film as now contended by appellant even if those short movements would accomplish any useful result.

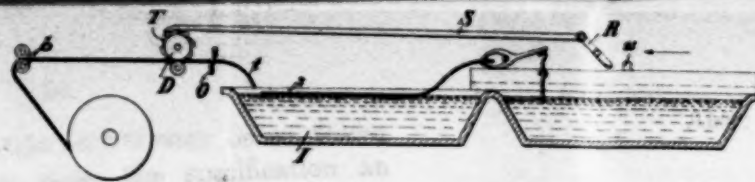


FIG. 2.

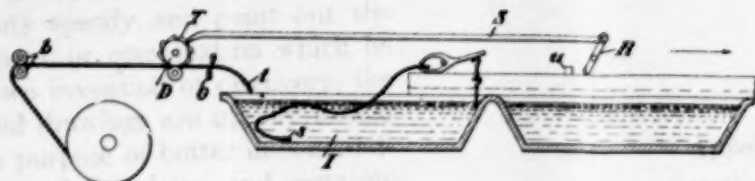


FIG. 3.

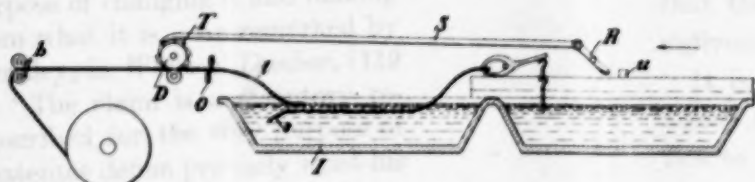


FIG. 4.

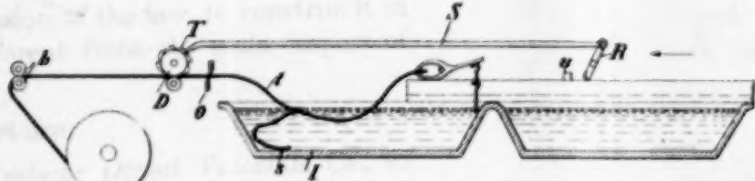


FIG. 5.

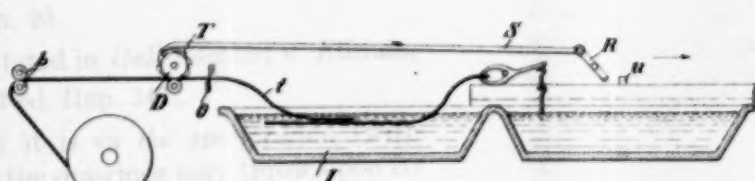


FIG. 6.

170057-20. (p. 16).

DRAWING SHOWING THAT THE FILM CLAMPS MUST BE MOVED CONTINUOUSLY IN ONE DIRECTION ONLY.

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In the annexed drawing (opposite page 16) is shown a series of sectional views of the machine of the patent demonstrating defendant's contention beyond peradventure.

Figure 1 is a reproduction of a portion of Figure 1 of the Beidler patent in suit, showing the paper or film gripped by the clamping device at the commencement of the operation of drawing the film or paper over the developing tank after the exposure has been made in the camera. In order that the portion of the film between the roll *b* (at the left end of Fig. 1) and the rolls *D*, which has been exposed, may be drawn forward the proper distance to allow the end *s* of the sheet which is severed by the knives or shears *O* to fall into the first developing pan *I*, it must be moved to the position shown in Figure 2, that is, until the pin *U* has *passed beyond and actuated* the lever *R* and operated the ratchet wheel *T* on the roll *D* to feed the end *t* of the film sheet from the severing knives *O* toward the jaws of the clamp, as shown in Figure 1.

Now, in order to submerge this end *s* in the new manner now described by claimant, it is necessary to move the rack to the left again, the parts then occupying the position shown in Figure 3 where the pin *U*, striking the lever *R*, turns it to the position shown, but without rotating the ratchet wheel *T* and the feed roll *D*. When the rack is moved to the right again to the position shown in Figure 4, the pin *U* on the rack again engages and turns the lever *R*, ratchet wheel *T* and roll *D*, thereby again moving the end *t*

of the film outward beyond the knife O the same distance as before, the film end *t* then occupying the position shown in Figure 4. It will be noted that under any theory of operation, a single oscillation of the lever R must rotate the roll D and move the film an amount equal to the distance between the knives O and the end of the gripping jaws of the clamp, as shown in Figure 1—for otherwise the clamps could never reach it—and that two oscillations of the lever R will therefore feed the film extending from the camera down into the pan, as shown in Figure 4, so that under no circumstances could its end *t* be grasped by the clamp when moved to the left, as described in the patent.

Inasmuch as in the operation of the apparatus the film and clamp are concealed from the operator's view, it is clear that more than two reciprocations of the frame or film holder will be necessary to submerge or even partially submerge the print grasped by the clamp, and as the location of the pin U and the lever R, as shown in the patent, is at the exact point to which the film-feeding device must be actuated by the frame or rack at each movement to the right if the film is to be kept in the pan, the end *t* of the film will have been fed so far down into the pan that it will be impossible for the clamp to reach it again. Therefore, after one attempt to submerge the film by reciprocating the rack and clamp it will be impossible to operate the device further. One more reciprocation of the

frame would feed the free end of the film still further into the pan, as shown in figures 5 and 6.

On the other hand, with the parts constructed as shown in the patent, if the clamp or rack is moved *progressively and continuously* to the right, without attempting to return it until the print is deposited in the last pan, the operation of dragging the severed print over the pans and the feeding of the end *t* of the film by the roll D in order that the end *s* can be engaged by the clamp would be possible, although this operation would be inadequate to cause the development, washing, and fixing of the print which is dragged with its sensitive face upward across the liquids in the pans, and the Court of Claims has so found as a fact. (Rec. p. 28, Finding IX.)

It appears, then, that the machine of the patent is wholly inoperative unless altered in vital particulars; and that when so altered it must be operated in a manner not contemplated by the specification if any practical result is to be obtained.

MACHINE OF THE PATENT WAS NEVER COMMERCIALY USED.

No machines within or embodying the mechanism of claims 17, 18, 33, 34, or 40 of the patent in suit have been commercially manufactured or used; nor have any machines ever been constructed and practically operated within the scope of the claims and by the disclosed method of operation of said patent, and the Court of Claims has so found as a fact. (Rec. p. 27, Finding VIII.) It appears that the only ma-

chines which appellant did place on the market were constructed according to other patents owned by appellant and *not included in this suit*. The patent in suit is a mere "paper patent" and it has been used as a "club" in an attempt to force the United States Government to buy the machines of appellant's *other* patents rather than the 'Photostat' which the Government now uses.

See *Troy Laundry Machinery Co. v. Columbia Mfg. Co.*, 217 F. R. 787-788.

PATENT IN SUIT IS INVALID IN VIEW OF THE PRIOR ART.

The prior art will be considered chronologically to show the step-by-step development of the photographic machines.

Ratzell, No. 112,380, of 1871.

This patent discloses a combination camera and developing box. In operating the sensitized plate is exposed and the developer fluid and water flowed over the plate from the tap *t*, *the plate being held by the manually actuated pliers L* (Spec. p. 2, par. 1), which extend through the oilcloth light-excluding hood L. The patentee states (Spec. p. 2, col. 2, lines 7, 8) in describing the operation of the device:

Take the pliers and take the plate off the dipper, and hold it under the taps.

Thus this very early patent discloses a camera and developing apparatus contained within a light-proof cabinet, and also discloses means for manip-

ulating the sensitized plate during the development. This is the same broad aggregation as that disclosed in the patent in suit.

Parker, No. 117,106, of 1871.

The Parker patent discloses a projecting apparatus *a*, a developing tank E, and a washing tank N. The plate is held in the developing tank (after being delivered to it by the member G) by the carrier *e* which is adapted to be raised manually and drawn to the left and then lowered to place the plate in the tank N. Clearly, this shows the association of a camera, a series of tanks for containing the developing and fixing fluids, and means for carrying the plate through the tanks. The carrier *e* is moved in one direction to carry a plate from one tank to the other, and is moved in the opposite direction to grip another plate with which to repeat the operation.

Waterbury, No. 133,394, of 1872.

This patent marks another step in advance and discloses a roll of sensitized paper which is held in the uppermost container and from which the paper passes downwardly between feed rolls and through the cameras AA. From the cameras the exposed paper film passes between rolls HH and may be cut off into proper lengths. The patentee states (Spec. p. 1, col. 2, lines 20 and 21):

Below the cameras may also be a suitable paper cutter.

Furthermore:

The finishing process will be like other photographic processes now well understood. (Spec. p. 2, col. 1, lines 31-33.)

This patent, therefore, shows the use of sensitized paper onto which the image is projected, the paper being subsequently cut, and the cut-off portion developed in the usual manner, that is to say, passed successively through tanks of developing, fixing, and washing fluids, such as described in the art existing prior to this patent.

Neil, No. 157,459, of 1874.

Neil discloses a "reciprocating" member for transferring a sheet of paper from the cylinder to the delivery board of a printing press, the action being similar to the alleged action of the film-carrying means of the patent in suit. A pair of cooperating jaws *e* and *e'* are actuated by a trip *q* to close when the gripping device is at the end of its movement toward the cylinder, and are opened by a trip *R* when the device is at the end of its opposite movement. The Neil patent is in an art very analogous to the photographic art, the only difference being that in the printing art the impression is made on the paper by means of type and in the photographic art by projection. In any event the transfer device *N* operates to transfer the sheet on which the impression has been made to a support or holder—similar to the transfer of a film to the developer holder.

Godfrey, No. 475,522, of 1892.

Here also is a machine for handling a strip of paper and in this instance the gripping means 49 engages the advance edge of the strip and pulls it from a roll until the proper length is obtained, at which time the strip is severed by the knives 76, 77. It is noteworthy that the strip of paper is coated (at 115, patent drawing), is gripped by the jaws 40-49 at the end of their reciprocating movement in one direction, is drawn off the roll until a proper length is attained, is cut off, is applied to the box (38, Fig. 12, patent drawing), and that at the end of the movement of the jaws 48, 49 in the opposite direction they are automatically opened to release the strip.

Perry, No. 420,355, of 1890.

This patentee, recognizing the difficulty arising from the curling of the film during development, contributed a film holder to the art. In this device the film is placed beneath the clips on the frame and is held flat during the development and fixing. It is possible with this device to place the film in the developing and fixing baths to manipulate it in such a manner that the fluids may be flowed evenly over the sensitized surface, and this without necessitating the placing of the operator's fingers or hands in the solutions.

Steffens, No. 429,705, of 1890.

This patentee made a still further advance in the art. In this patent the flexible films are exposed in the camera and carried automatically and succes-

sively through the developing, etc., baths. Specifically, after the image is projected on to the film by the camera, the film passes between the endless belts R and R' and is conveyed thereby through the several baths and finally delivered to the chute N (Fig. 3), from which it passes from the machine—the same general aggregation as illustrated in the patent in suit.

Wight, No. 616,999, of 1899.

This patent is valuable to the extent that it shows a reel e^3 (Fig. 2), to which is attached one end of a film N', which film enters the light-proof cabinet a^2 through a suitable slit. The tray K, containing the proper developing or fixing fluid, is raised from the position shown in Figure 2 "until the solution in the tray comes up to the film on the reel." (Spec. p. 1, lines 43, 44.) The film is cut to the proper length by the cutter a^6 and the reel rotated to carry the film through the solution in the tray. In short, we have in this patent a tray for the developing fluid, a roll of film, means for cutting off a portion from said roll, and means for carrying the cut-off portion through the bath in a tray—broadly, the same result which appellant's "reciprocating" film-conveying means is supposed to accomplish.

British, No. 1,015, of 1899.

A photographic apparatus is disclosed in this patent in which the film roll L is mounted in a chamber K. The film is fed to the lower chamber B, where a por-

tion is held by the holder D, and which portion is cut off by the knife S. The holder is then manipulated to lower the film into any of the several fluid containers E.

Fleischer, No. 683,031, of 1901.

Fleischer follows in 1901 with a very similar device where the film is cut off by the knife K² and the cut-off portion lowered into the solution C.

Pollak & Virag, No. 688,115, of 1901.

In 1901 Pollak & Virag obtained a patent disclosing the association of a camera 29 which projects the image onto a portion of a film obtained from a roll; means 31 for cutting the exposed portion from the roll; a series of tanks 4, 8, 22 for containing developing, fixing, and washing fluids, and means in the form of an endless conveyor for carrying the cut-off portion of the film to the several containers and through the several solutions therein. All of this is inclosed in a light-proof cabinet. *The device of the patent in suit differs from this device only in the specific means for conveying the film through the baths.* In the Pollak et al. device the film is conveyed by the endless conveyor, while in the appellant's device the film is carried by clips on racks which move in one direction and return in the opposite direction instead of completing the circuit. It is noteworthy that in appellant's device when the racks move in one direction they carry the exposed film with them, and when they move in the opposite di-

rection they are free of the film, and that in the Pollak et al. device when the film is engaged by a portion of the endless conveyor the movement of *that portion* is away from the camera, but when that portion returns toward the camera it is likewise free of the film, the film having been released therefrom at the end of its outward movement. At most, the only novelty in appellant's device over the Pollak device is in the particular form of the film-conveying means; but even this is not patentable novelty as the means in the Pollak et al. device is the equivalent thereof, in each case the film being acted upon while the conveying means moves in one direction, and being released at the end of that movement. It therefore makes no difference how the carrier returns as it has, then, no function so far as the treatment of the film is concerned.

Dudley, No. 740,828, of 1903.

This patent is interesting in that it shows a light-proof container 5 for developing fluid and shows further "reciprocating" means 13 for clamping the leading edge of the film and drawing it through the fluid, said means being manually operated.

Beldler, No. 810,388, of 1906.

Appellant in 1906 obtained a patent which shows the same broad aggregation as that set forth in the claims in suit. This patent discloses a photographic apparatus; means 13 for holding a supply roll of film, which means is light proof and constructed to

protect said film from actinic light rays, and has means (holder 8) for subjecting a portion of the film to the action of such rays; receptacles 16a within the casing 1 for containing developing fluids; means (the endless conveyor 34, 35) to carry the film through the tanks, and means for severing the exposed portion of the film (knife 49c). *This patent discloses, therefore, all that is disclosed by the patent in suit, except the specific form of the film-conveying means.*

Beldler (Reissue), No. 12,834, of 1908.

This is a reissue of patent No. 810,388, and in so far as it is of interest in this suit, discloses the same as the original.

Prentiss, No. 830,741, of 1906.

Prentiss discloses a roll of film 5 on which is printed the images at 7, 8. The film then travels through developing, fixing, and washing baths B, C, and D, respectively, being carried there through by endless conveyor F. This patent is of particular interest in that it shows a series of open, horizontal trays and means for carrying the film through in said trays, and in fact discloses all but the particular form of the film-conveying means. It is therefore evident that *if there is any novelty in appellant's patent in suit over this Prentiss patent it is in the specific form of the film-conveying means*, but this means, as has been shown, is inoperative to accomplish any useful result.

SUMMARY OF DISCLOSURES IN PRIOR ART.

The prior art shows that before the filing of the application on which the patent in suit issued photographic machines of the same general character as that disclosed in the patent in suit were old; that is to say, photographic machines for continuous-process photography, having *combined and cooperating* mechanical means (a) for holding a supply of film (or print paper), (b) for supplying a portion of such film in proper position in the camera for the photographic exposure and exposing the same, (c) for conveying the exposed portion of film to a light-proof chamber having receptacles for developing, fixing, and washing solutions or liquids, (d) for detaching the exposed film, and (e) for conveying it successively through the developing, fixing, and washing solutions or liquids for the development and finishing of the negative or print.

In the structures disclosed by said patents all of the above-enumerated means are substantially the same as in the structure or machine of appellant's patent in suit with the exception of the means for conveying the exposed section of film through the developing and other solutions or liquids. In some of said patents this operation is performed by means of continuous or endless belt or apron carriers, operating upon rollers, by which the film is held and carried successively down into and up out of the trays or receptacles containing the developing, fixing, and washing solutions or liquids; and in others of

the patents it was performed by manually operated reciprocating means. There was also in the printing art at the time of appellant's application for his said patent an automatic *reciprocating* device for engaging and transferring the printed sheet from the cylinder of the press to the delivery board, which device is very similar in character and action to the said film-conveying means of appellant's patent in suit and is from a closely analogous art. (Rec. p. 26, Finding VI.)

It, therefore, is evident that if there is any novelty in the device of the patent in suit it is in the *specific form* of the reciprocating means and *this form is not specifically claimed in the claims in suit and is different from the transfer means used by defendant as is hereinafter pointed out.*

**THE CLAIMS IN SUIT DO NOT DEFINE A PATENT-
ABLE INVENTION IN VIEW OF THE STATE OF
THE ART.**

Appellant has elected to sue upon claims 17, 18, 33, 34, and 40. (Rec. p. 16.) The only difference between the elements recited in these claims and the apparatus shown in the Pollak & Virag patent No. 688,115 and the prior Beidler patent No. 810,388 is that the film-carrying or feeding means is stated to be a *reciprocating* film moving means, and, for the reasons hereinafter stated, *this term does not, in view of the prior art, define a patentable difference.* In any event the disclosure of the prior art is such that a very strict construction of the claims is necessary

even if they are held to embody patentable subject matter and they must be limited to cover only a structure having precisely the same mode of operation as that shown and described in the patent.

The elements of a representative claim and those in the prior patents are as follows (see drawings opposite page 29):

Beidler patent in suit.
Claim 17.

(1) Means for holding the supply of film and protecting it from light.

(2) Means for subjecting film to light.

(3) Liquid holder.

(4) Film - feeding means between the holder and supply of film.

(5) Reciprocating film moving means receiving the film and carrying and subjecting it to the action of liquid.

Pollak & Virag.

(1) Camera 29.

(2) Camera shutter.

(3) Tank or pan 4.

(4) Rollers 32 and 33.

(5) Belts 13, rollers 17 and 19.

Beidler No. 810,388.

(1) Camera box 4.

(2) Shutter of camera or slide 7.

(3) Developing tray 16 (also 16b, 16c, Fig. 7).

(4) Rollers 49 and 50.

(5) Belts or aprons 34 and 35.

The combination of a film-exposing camera, a film-severing means, and a film-carrying and developing means is thus shown to be old in the prior art and clearly there is no new combination recited by the mere statement that one of the elements, i. e., the film-moving clamp, *reciprocates*, when this performs no function in the broad combination, excepting to cause the clamp's return to its initial grasping position. The exposure of the film has been accomplished before the conveying and developing device functions

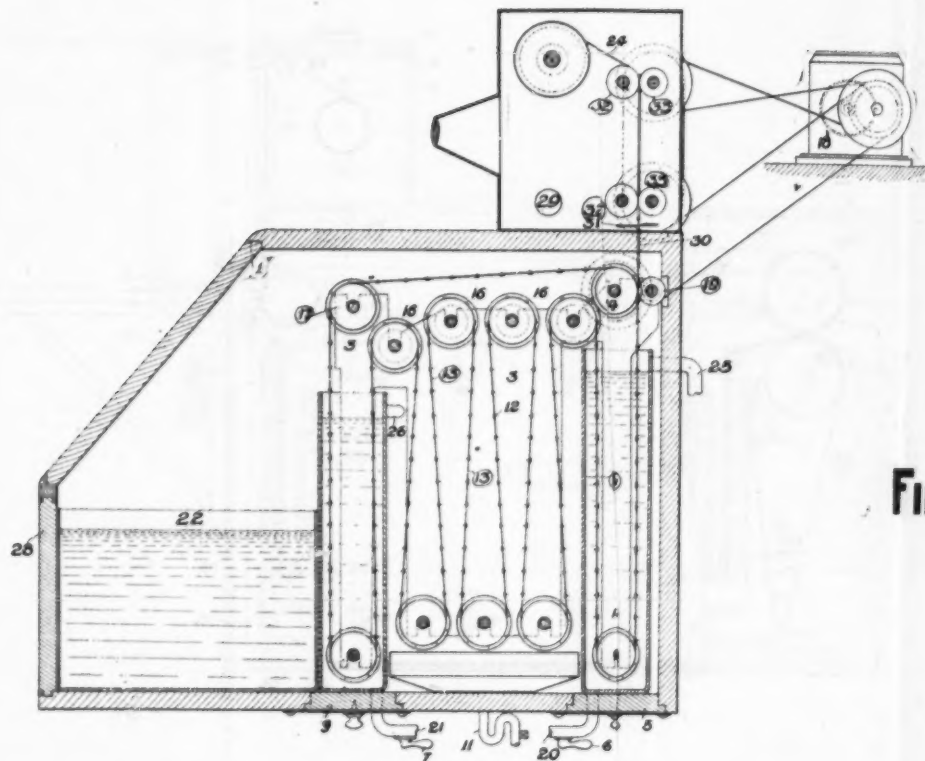


FIG. 1.

roll D, and the projection of the end of the film in the camera beyond the cutter O, inasmuch as the clamp jaws *must* be closed and opened by the pins *n* and *m* and the feed rollers D must be operated by the ratchet wheel T, the pawl S, the lever R and the pin U on the reciprocating rack for each exposure.

Thus in order to distinguish the patentee's invention from the prior art in a patentable sense, the word reciprocate or reciprocating, as applied to the film-carrying devices, must necessarily refer to some structure which has the *essential characteristics* of that disclosed in the patent and, as will be shown hereinafter, that characteristic feature is not contained in the apparatus used by defendant.

**WHETHER OR NOT THE CLAIMS IN SUIT ARE
VALID, THERE IS NO INFRINGEMENT, AS THERE
IS NO IDENTITY OF MEANS, OPERATION, OR
RESULT.**

Defendant's machine.

Structure.

Defendant since 1911—two years prior to the issue of appellant's patent—has been using a type of machine known as "Photostat," which machines, it is claimed, infringe the patent in suit. This type of machine, as illustrated (on page opposite to page 32, brief), comprises a camera behind which is a film-supply receptacle B containing a roll of sensitized paper. This paper is adapted to extend downwardly behind the camera in the space F where the exposure is made. At the lower end of this space

F hand-operated feed rolls D—D are located, and between which rolls the paper passes. Located behind the rolls D—D, a knife O, actuated by the handle O', cuts the paper into the proper lengths after the exposures have been made. A series of trays I, J and J' is carried by a suitable support and the foremost tray I is located beneath the feed rolls to receive the sensitized and exposed portion of the film, which film is fed to the tray I with its sensitized surface *down*. This tray I is adapted to contain the developing fluid and the other trays to contain the fixing and washing fluids. The tray I is covered by the light-proof hood A so as to exclude light rays during the development of the film.

When these machines were first manufactured—that is, from 1910 to February, 1911—the films were manipulated in the developing bath as well as in the fixing and washing baths directly or entirely by the hands or fingers of the operator (Rec. p. 21, lines 9, etc.), the film after development being drawn successively into the fixing and washing trays. However, since February, 1911, means has been provided for handling the prints in the developing bath, *which means is, however, in the nature of a tool separate from the machine itself*, a device such as illustrated (on pages marked 25 and 26 of the record and on page opposite page 32 of this brief) being used, which device was manufactured under authority from the owner of U. S. letters-patent to Greene, No. 1,001,019, dated August 22, 1911. This device (see drawing opposite page 32), a print-han-

dling slide M (Rec. p. 20, Finding IV), has a plate-like bottom resting on the bottom of the developing tray, with a number of perforations or holes *h* therein, ribs, or ridges *b*, on its upper surface for forming limited points of contact with the film or print when it rests thereon and the clamping fingers *N* attached to the ends of the finger bars *N*² for clamping and holding the print after it is fed between these fingers and the bottom of the slide. The finger bars *N* are pivoted to vertical posts *n*² rising from the bottom of the slide, and are connected together by the handle bar *N*¹; and the fingers *N* are normally held in a raised position with relation to the bottom of the slide by the tension springs *n*³ against the under sides of the finger bars *N*² to allow the film or print to be fed between the finger bars and the bottom of the slide. The handle bar *U* is connected rigidly to the rear portion of the slide.

Operation.

The mode of operation of the machine is as follows (Rec. p. 20, Finding IV):

The film roll *W* being in place in the film-supply receptacle *B*, and a portion of the film (*F*) being in position for the photographic exposure, the developing hood *A* being closed down to exclude the light from the developing tray *I*, and with the developing tray *I*, the fixing tray *J*, and the washing tray *J'* properly supplied with their respective fluids, and the slide *M* in the developing tray being well forward in the tray for receiving the exposed film to be developed, the exposure of the film or sensitized paper

is then made in the usual way. Then by hand-crank rotation of the film-feeding rollers D—D the exposed portion of the film or print is fed downward through the slot just below the rollers and into the developing tray and liquid, guided by the finger guides V of the tray, and passing above the bottom of the slide M and between it and the raised fingers N of the spring-supported finger bars N^2 . The exposed section of the film or print is then cut off just below the film-feeding rollers by the knife O, operated by the hand crank O'. Then by the operator grasping and pressing together the movable handlebar N' and the fixed handlebar U of the slide M, the terminal fingers N of the pivoted finger bars N^2 are, by the resulting upward movement of the handlebar N' , and against the tension of the springs n^3 , pressed down until the print is grasped between them and the bottom of the slide. The slide is then drawn, with the print, back in the developing tray and liquid, and any small portion of the severed film next to the knife which may not already have passed into the developer is thereby drawn therein. All these movements are to be performed quickly in order that all portions of the paper shall be subjected to the action of the developing fluid as nearly as possible the same length of time, this being essential to good photographic work. When the paper has been in the developing fluid the proper length of time, ordinarily about 30 seconds, the slide M is drawn back, the rear end upward onto the back and partially out of the developing tray and

chamber, bringing with it the developed print which is *then drawn by hand out of the slide and by hand successively put through the fixing bath and the washing bath* in the open fixing tray J and washing tray J', thus completing the photographic process. The slide M being returned to and placed in the developer tray, the machine is ready for a repetition of the process, a new unexposed section of the film having been brought into position for exposure by the action of the film-feeding rollers in feeding the formerly exposed section of film into the developer tray and liquid.

COMPARISON OF MACHINE OF PATENT IN SUIT AND DEFENDANT'S MACHINE.

Machine of Claimant's Patent.

1. The patented machine is automatic and mechanical throughout, particularly in the transportation of the prints.

2. The feed rolls D only advance the paper into the path of the clips and no more. They are entirely and solely mechanically and automatically operated through the lever R, pawl S, and ratchet T, and actuated by the movement of the transporting device, or rack M. These feed rolls do not move the print into the developer in operating the device—according to the specification; in fact, have nothing whatever to do with that.

3. The cutter O is the only thing that causes the print to get into the developer pan since the film must be cut before it can fall into the pan.

Defendant's Machine.

1. Defendant's machine is hand-operated throughout and particularly in the handling of the prints.

2. The feed rolls D feed the paper directly into the liquid in the developer pan I. They are hand-operated (through a crank-handle). There is no advance feed of the paper in defendant's machine and no reason or object for any such feed.

3. The cutter O has nothing whatever to do with the print getting into the developer pan since it is already there before cutter O is operated.

Machine of Claimant's Patent—Con.

4. Clips N are automatically opened and closed by the movement of the crack M to which they are secured. The trips for operating such clips are at the extreme ends of the path of the rack.

5. Rack M and clips N carry or pull the print from the supply roll W out of the camera or exposure chamber into the enclosed casing A and over the several pans therein in succession releasing them over the last pan—all performed mechanically and automatically.

6. All parts of the machine are enclosed in a casing and entirely inaccessible, particularly during operation, to the operator's hand.

Defendant's Machine—Continued.

4. No corresponding feature in defendant's machine. Even if the depressible handle of the developer slide itself be regarded as the counterpart of the clips then there is no proper comparison, since such developer slide "clip" is not automatically operated; there are no trips to operate it; it is operated entirely by the fingers of the operator.

5. Nothing to correspond in defendant's machine. Feed rolls D pull the print off the supply roll W, pull it out of the camera and into the first developer pan I only. From there on everything is done by the direct application of the operator's hand, and particularly the transfer of the print out of the developer pan and into the succeeding pans. To be minutely exact, the developer slide intervenes between the hands of the operator and the print itself *in the developer pan only*, but this is not for the purpose of conveying or transporting the print, but is merely to obviate staining the operator's fingers and contaminating the solution.

6. All parts of the machine throughout the entire process of manipulating the print are readily accessible to the operator's hands, who can and does, from the time the print enters the first developer pan I, handle and manipulate the print throughout the entire process with his hands.

Machine of Claimant's Patent—Con.

7. The characteristic and distinguishing feature is the automatic and mechanical print conveyor made up of racks M and clips N as differentiating from carriers of the prior art that consisted of endless tapes or aprons that mechanically transported the print from the camera to and through several baths in succession.

Defendant's Machine—Continued.

7. This feature is entirely absent from defendant's machine, as there is no mechanism for moving the print from the developer to the succeeding baths.

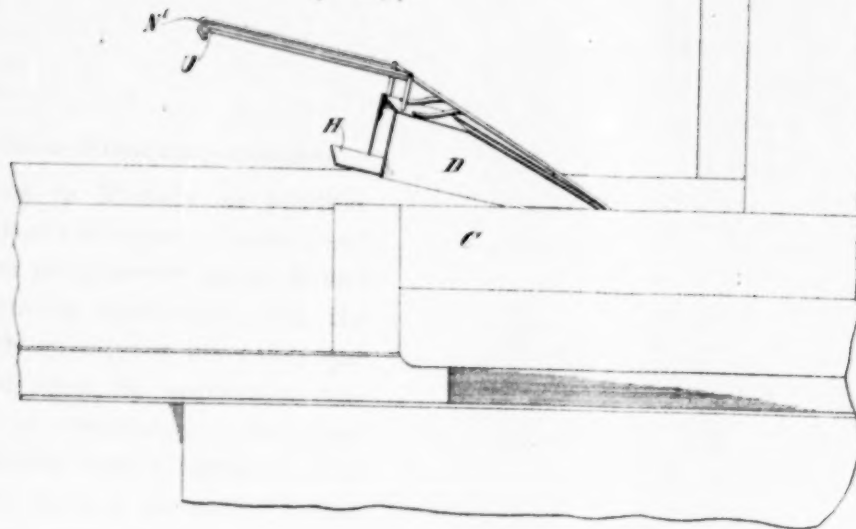
Claims in suit do not cover defendant's machine.

Considering the claims as liberally as possible, they do not cover defendant's machine. Leaving out of consideration that the print-carrier (racks M and clips NN and their operating mechanism) was the the only thing on which novelty or invention was (or could be) predicated when the application was filed; also leaving out of consideration the point that substituting a particular form of carrier such as this for the old aprons or tapes of the earlier Pollak *et al.* and Beidler patents, does not give appellant herein the right to claim *the whole machine* as the invention of the patent in suit, the claims in suit may be compared as far as feasible with defendant's machine. The conclusion of noninfringement follows:

Considering claims 17 and 18 (which are alike, except that the latter uses the expression "a reciprocating film clamp" in place of "reciprocating film-moving means" in the former) it may be conceded *arguendo* that these claims may be applicable to defendant's machine down to and including "a liquid holder."

15.5

FIG. 2.



170057-20. (p. 41).

DRAWING SHOWING HOW PRINT-HANDLING DEVICE IS LIFTED FROM THE DEVELOPING PAN.

as before pointed out, is the so-called "novel" means in the patent, and is the rack M with its clips N and their operating mechanism (Pat. p. 1, l. 64-107). Its function is—

to convey the sensitized film through a series of receptacles containing suitable developing and fixing fluids, or through suitable baths, according to requirements. (Pat. p. 1, l. 13-18.)

Also:

to draw the film through the several compartments. (Pat. p. 1, l. 64-65.)

* * * * *

as rack is moved outwardly the film is carried through the several tanks as indicated. (L. 81-83.)

It is a *transporter or conveyor*.

In defendant's machine the separate and disconnected developing slide is charged by plaintiff as being this carrier. But it is clear that it is no such thing. *It does not transport or convey the films.* It is a mere hand tool and no part of the machine. It is for the purpose of lifting the print out of the developer—not to carry it into and through it.

In the patent specification the clamps N are described as moving in one direction, that is to the right, to carry the cut-off portion of the film through the developing fixing and washing fluids. In other words, their function is to submerge the film in the several solutions (although they are inoperative to do this as has hereinbefore been pointed out). In the

model which appellant introduced into evidence, a series of short reciprocations are given to the clamps N for the purpose of submerging the film in the developing fluid. Whether the term "reciprocating" in the claims be read broadly enough to comprehend this latter mode of operation or be confined to the former mode which is disclosed in the specification of the patent, is entirely immaterial so far as the question of infringement is concerned.

The fact is the clips N are mounted in the patented machine so that they move in opposite directions in a given path and for the purpose of drawing the film through the developing, fixing, and washing fluids. The print-handling device used in the Photostat by defendant is not a "reciprocating" element in any sense of the word. *It is simply a tool independent of the machine which is insertable into the developing tank. It has no fixed or definite path of movement. Its movements and directions of movements are controlled by the operator and it is not for the purpose of drawing the film through the developing fluid, the fixing fluid, and the washing fluid or any of them, but for the purpose of removing the film from the developing solution.* The film is fed into the developing fluid by the feed rolls of the Photostat, and after being so fed is gripped by the print-handling device (which is best shown in the drawings of the Greene patent opposite p. 20, Rec.). After the film is so gripped, the print-handling slide is drawn rearwardly within the developing tank and raised over the rear edge thereof into such a position as is shown in the accompanying drawing (opposite p. 41), which drawing is a reproduction of a page

of the Photostat trade catalogue which was introduced into evidence in the Court of Claims. In this drawing the slide is indicated by the letter D and is clearly shown in its raised position with the hood A, which is adapted to enclose the developing tank, swung into its upper position to permit the actuation of the slide.

After the slide is moved into this position the print H is removed therefrom by the fingers of the operator and the print is then passed by the fingers of the operator through the fixing solution, the slide remaining at all times in the developing tank. It will therefore be seen that the slide does not reciprocate and that its function is not to draw the film through the several solutions or even through the developing solution, and it is not a developing slide in any sense of the word since the development of the print is not dependent upon the slide but upon the fact that the print is fed into the developing solution by the feed rolls. The slide is nothing more than a hand tool which is in the nature of pincers and its function is to remove the developed print from the developing solution so that it may be subsequently placed in the other solution by the operator. It merely takes the place of the operator's fingers and obviates the necessity for his placing his fingers in the developing solution with the consequent results unpleasant to him and detrimental to the solution.

It will therefore be seen that there is no identity between the structure, mode of operation, or the result of the slide used in the Photostat, and "the recipro-

cating means" of the patented device, and therefore there can be no infringement of any claims of the Beilder patent in suit.

**THERE MUST BE (1) IDENTITY OF MEANS,
(2) IDENTITY OF OPERATION, (3) IDENTITY OF
RESULT FOR INFRINGEMENT TO EXIST.**

The law that there must be substantial identity of means, operation, and result between the machine of the patent and the alleged infringing machine for the latter to constitute an infringement is well settled by a long line of decisions, among which are:

Kokomo Fence Machine Co. v. Kitselman,
189 U. S. 8.

*Pittsburgh Meter Co. v. Pittsburgh Supply
Co. (C. C. A.)*, 109 Fed. Rep. 644, 651.

Masseth v. Larkin (C. C. A.), 119 Fed.
Rep. 171, 174.

*United States Envelope Co. v. Sherman En-
velope Co.*, 122 Fed. Rep. 464, 466.

There is no infringement if there is merely identity of result and not identity of operation. *Cimiotti Un-
hairing Co. v. American Fur Ref. Co.*, 198 U. S. 399,
414. Nor is there infringement even where the
terms of the claims are infringed unless the principle
of operation is substantially the same. (*Standard
Computing Scale Co. v. Computing Scale Co. (C. C.
A.)*, 126 Fed. Rep. 639.)

From the preceding comparison of the machine of
the patent in suit and the defendant's machine, it
will be seen clearly that there is non-identity of
means, non-identity of operation, and non-identity of
result.

CLAIMS IN SUIT ARE MEANINGLESS, BEING VAGUE, INDEFINITE, AND AMBIGUOUS, AND ARE THEREFORE INVALID.

It is well understood that infringement can only be of some claim or claims of a patent; but the claims of the patent in suit are meaningless. They are so vague, confused, and ambiguous as to defeat the very purpose for which claims are prescribed. Instead of marking out and defining the invention, the claims obscure and confuse it. The invention must "emerge from the specifications," and the claims are to particularize *from the specification what is new as therein disclosed*. As the statute requires (sec. 4888, R. S.), the inventor—

shall *particularly* point out and *distinctly claim* the part, improvement, or combination which he claims as his invention or discovery.

Each of the 41 claims should be a distinct invention from the other (*Leeds & Catlin v. Victor T. Mach. Co.*, 213 U. S. 301, 319); and though only 5 of them are herein declared to be infringed, yet the meaning of each of those claims has to be differentiated from the others, in order to avoid a construction that would make two or more claims of the patent identical. As said in *Scaife & Sons v. Falls City W. Mills* (C. C. A.) 209 Fed. Rep. 210—

* * * proper construction and effect can be given to each claim only by differentiating it from the other claims. *Each claim should be capable of such differentiation, else it has no right to exist.* (P. 214). [Italics ours.]

See also—

Tate v. B. & O. R. R. (229 Fed. Rep. 141, 144).

McCarty v. L. V. R. R. (160 U. S. 110, 116).

It is no wonder that in cases such as this courts condemn and discourage such loose claim-writing by invalidating them for ambiguity or vagueness. As said in *Victor T. Mach. v. Edison* (229 Fed. Rep. 999 (C. C. A.)):

* * * the practice is so obviously mischievous that *the courts should discourage it as much as possible, as well as the practice which permits 48 claims upon a simple and perfectly obvious machine like this. Such claims violate the very purpose of any claims at all, which is to define the forbidden field. In such a waste of abstract verbiage it is quite impossible to find any guide. It takes the scholastic ingenuity of a St. Thomas with the patience of a yogi to decipher their meaning* * * *.
[Italics ours.]

Also *Carlton v. Bokee* (17 Wall. 463).

But it is clear what, if anything, the alleged invention consisted in. It is no more than a mechanical carrier or conveyor for the prints, of the rack-and-pinion type, that when moved forward will automatically grip the prints that have been automatically advanced to be in its path, and when moved backward will drag the print from the exposure chamber over the whole series of baths necessary to make a finished picture and

automatically drop the print in the last bath—everything but the operating handle being inaccessible to the operators and inclosed in the light-tight casing A.

The holding of the Circuit Court of Appeals (Grosscup, J.) in *State Bank of Chicago v. Hillman's*, 180 Fed. Rep. 732, 736, is here directly in point:

The question of law presented, then, is this: Can the patentee rightfully include in his claims *something that does not emerge from the description?*

We think not. The description is required to set forth the invention in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it appertains or with which it is most nearly connected to make and use the same; and the claim is to enable the public to know the bounds and scope of the invention "thus disclosed"; but "*any claim which is broader than the described invention is void, even where that invention is valuable and could have supported a valuable claim.*" (Walker on Patents (4th ed.), sec. 177, citing *Edison v. American Mutoscope Co.*, 114 Fed. 934; 52 C. C. A. 546.) [Italics ours.]

Having ascertained the nature of the invention disclosed in the patent in suit, the claims in suit (claims 17, 18, 33, 34 and 40) may be considered.

The invention is in a "photographing and developing apparatus" (see title of patent, also *l.* 9-17, p. 1). But claims 17, 18, 33 and 34 here in suit are not for such apparatus, but on the contrary are for a "*photographing apparatus*" only—as they state;

while claim 40, also in suit, is for a "photographing and developing apparatus." How shall this difference be construed? Or shall it be ignored?

Again, claims 17, 18, and 40 specify—

the combination of means for holding a supply of film, constructed to protect said film from actinic rays of light *and having* means for subjecting *a portion of film at a time* to the action of such rays, etc. [Italics ours.]

But claims 33 and 34 include no means for subjecting *a portion of film at a time* to the rays—otherwise they are respectively identical with claims 17 and 18 (except for another difference in claim 34 to be presently noted). Shall this difference be construed to mean that claims 33 and 34 subject *all* the film to the rays? But the specification neither shows nor suggests any construction that could expose *all* the supply of film at a time to the rays. Moreover, *there are no means for exposing the film at all* in these two claims—only means to *protect* it from exposure. To read the means for exposing only a portion of the film into claim 33 would be to invalidate it by making it identical with claims 17 and 18; and to read it as it stands would invalidate it because it defines a useless structure, viz, *one that does not expose the film at all* and hence receives no image or photographic impression; and, further, *one that is without the knife to allow the film to fall in the developer.*

Again, no knife, cutter, or other means for cutting off the exposed prints is specified in claims 17 and 18

(which expose only a "*portion* of film at a time"), nor in claims 33 and 34 (which do not expose any of the film). But a cutter is specified in claim 40 which ends "and means for severing the film." Are claims 17 and 18 to be rewritten by the court to include the cutter; and if so, are claims 33 and 34 also to be similarly rewritten even though nothing is said therein about exposing only *portions* of the film at a time?

Again, in claims 17 and 18 it is specified—

The combination of means for holding a supply of film, constructed to protect said film from actinic rays of light *and having means for subjecting a portion of film at a time to the action of such rays, etc.* [Italics ours.]

What is meant by this language? What is the subject of the italicized portion "and having," etc.? According to these claims it is *the means that hold the supply of film protected from actinic light* that is to have these means to expose a portion thereof to such light. But what *is* the means to hold the supply of film protected from light? The specification does not explain. Assuming it to be "compartment B adapted to contain sensitized paper, preferably to roll form" (Pat. *l.*, 43-45, p. 1), this, according to the claim, *protects* the film supply from light. But if so, this chamber B has no means for subjecting a portion of the film to the light. *Another and different feature* permits that, viz, exposure chamber F (Pat. *l.*, 51-57, p. 1). These claims 17 and 18 are therefore not referable to the specification and do not "emerge therefrom," as is necessary. They specify something

foreign to the invention disclosed. This material discrepancy can not be corrected without rewriting these claims.

Again, claims 17, 18, 33, but not 34, specify:

And a reciprocating film-moving means (or film clamp, claim 18) situated to * * * subject the film to the action of the liquid in the liquid holder.

Passing over the point that "the liquid holder" does not agree with the specification, since that prescribes *at least* three liquid holders—or *more*, but never less (Pat. l. 60 p. 1)—it is to be noted that these claims require that the "*reciprocating film-moving means*" (i. e., the racks M and clips N) subject the film to the action of the liquids. *But as a matter of fact they are incapable of doing anything of the kind.* It has been already pointed out that the film can not get into the liquid without the intervention of the knife O. Indeed, this is specifically claimed in claims 23 and 24, where precisely the same feature is defined as—

means for *stretching the film over*, the means for containing the solution, and *means for severing the film to permit it to fall into the solution.* (Claim 23.) [Italics ours.]

Of course, then, if the film is not cut or severed it can only be "stretched over" the pans *and never will get into the solution at all.*

Claim 34 is also for an incomplete and inoperative aggregation. Aside from having only "means to protect the film from exposure" and no "means to

permit exposure"; and aside also from having no cutter by the operation of which alone the film can reach the liquid in the receptacles, this claim differs from claim 33 in omitting any mention of the "reciprocating film clamp" (reciprocating film-moving means in claim 33) as acting to "*subject the film to the action of a liquid in the liquid holder*" as does claim 33. Hence if this claim is not to be rewritten for the benefit of the appellant as against defendant, then this claim is for a wholly inoperative aggregation—not to mention the omission of the knife which would also have to be written into it.

Claim 40 further specifies "*reciprocating developing means operative to develop said exposed film.*" But these so-called reciprocating "developing" means are the rack M with the clips N, and these are *not* "operative to develop" the film, because, as seen, the film can never get into the knife O (also specified in this claim) to free the end of the film and "*permit it to fall into the solution*" (claims 21, 23, and 24). This misnamed "developing means" is merely a "suspending means," holding the film merely "in position to subject the film carried thereby to the action of the liquid" (claims 8, 13, 14, 15, 16, etc.). Again, it is merely a *film-stretching* means, i. e., "means for *stretching the film over* the means for containing the solution" (claims 23, 24).

Again, "means for *delivering* the film from the exposing means *to the reciprocating developing means*" in this claim 40 is wholly misdescriptive of the pat-

ented construction. The parts so referred to are the feed rolls D and the pawl S and ratchet. These parts are only operated on the *rearward* movement of the rack M and clips N. That is, the clips N have moved entirely away from the film "delivered" by the feed rolls when such "*delivery*" takes place (pin V has to pass beyond lever R to effect this so-called delivery). How, then, can a thing be said to be *delivered* to another *when that other is not there to receive it*? Furthermore, *the clips already have a section of film in their grasp* when this co-called "delivery" thereto is made. As the specification clearly states, the feed rolls D merely move the film "a short distance * * * in order that it may be *in the path of travel* of the clips" (Pat. 2, 1.1), but the *clips are not there* when this is effected; they are traveling in the opposite direction with a section of film already in their jaws.

SUMMARY.

Defendant submits:

(1) Defendant's "Photostat" machine does not correspond to, nor is it the equivalent of, the device disclosed and claimed in plaintiff's patent. It differs therefrom in structure, mode of operation, and in result attained.

(2) Said "Photostat" machine does not infringe any of claims 17, 18, 33, 34, or 40 of the patent in suit, which claims are sued upon.

(3) The patent in suit No. 1057397, dated March 25, 1913, is void because of insufficiency and vague-

ness of disclosure; as lacking patentable invention; as being an aggregation of old and non-coöperating elements; for want of novelty and utility and vagueness and ambiguity of claims.

The decision of the Court of Claims holding the claims of the patent in suit invalid and not infringed should be affirmed.

Respectfully submitted.

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